

however, is quite different from that of the claimed invention. The purpose of Applicant's device is to provide a heavy duty durable clip which will hold and grasp a significant thickness of material between the clip end and the barrel or body of the writing implement. The Krause device, conversely, is designed so as to provide some clip displacement yet maintain the sleekness of the elongated barrel design. This fact is born out by the structure of the Krause clip. By utilizing the ball clip at the end (See Krause FIG. 1 and 5), the Krause clip is inherently weak for holding or attaching to a thickness of material. The Krause ball clip itself will accommodate only a single point of contact where its outer ball surface clips onto the secured material. As such, this single point contact will not prevent the material from rotating and slipping out of the grasp of the clip.

Applicant's device, on the other hand, includes a wide flat surface on the underside of the clip member (11). This surface will allow the clip to obtain a secondary hold on the grasped material, thereby creating increased leverage to securely hold the materials through the combination of the spring action clip end and the flat underside of the clip.

Similarly, Applicant's device can be constructed with a wide range of angular displacement relationships between the clip and the implement body. By changing the size of the flanges, as well as their radial location with respect to the body, the angular displacement may be dramatically increased. The Krause device, on the other hand, may employ only a very limited angular displacement of its clip. Because the clip is imbedded in a recess, the displacement is limited to the depth of the recess, which is in turn limited by both the thickness of the body and the minimum inside diameter of the body sufficient to encapsulate the internal components of the writing implement. Indeed, the displacement of the Krause device is limited to the arctangential value defined by the depth of the recess. For a writing implement of common and typical size, the displacement of the Krause design will therefore be severely limited in comparison to the Applicant's invention, which may employ flanges of various sizes to increase the angular displacement. Thus, the Applicant's claims are not anticipated by Krause, as Applicant's invention includes and utilizes a different structure and exists to serve a different purpose than that of Krause.

Applicant respectfully disagrees with Examiner on the rejection of claims 1-6, 8-11,

14-18 and 20-22, as noted above. Applicant has, however, amended claims 1-6, 8-11, 14-18 and 20-22 as per the attached amended claims so as to clarify the points at issue. Applicant therefore respectfully requests Examiner review these claim amendments and recognize that the application is in condition for allowance.

**Claim Rejections based upon 35 U.S.C. §103:**

**Claims 12, 13, 23 and 24:**

The Examiner rejected claims 12, 13, 23 and 24 under §103 as unpatentable over Krause (1808045) in view of Kehr (2272674). Based on the above discussion of Krause, Applicant respectfully disagrees with Examiner that Kehr is even at issue here. Applicant also disagrees that the combination of Krause and Kehr references renders Applicant's invention obvious.

Kehr does not disclose, nor does it claim, a clip mechanism for a writing implement to include advertising depicted on the surface of a rigid member. The Kehr FIG. 7, referenced by the Examiner, depicts a tie clip, not the clip of a writing implement. Moreover in the Kehr disclosure concerning a writing implement clip, it discloses only that the rigid member "terminates at its forward end in a hollow ball 6". (See Column 2 at lines 13-15). There is no location for, nor any disclosure of, any area on the writing implement clip which would be appropriate for, or even adequately sized or shaped for, an advertising or graphical imprint area.

Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. *Ex Parte Hiyamizu*, 10 USPQ 2d 1393, 1394-95 (B.P.A.I. 1988). Therefore, Kehr does not render the claimed invention obvious, as it does not disclose or claim any advertising or graphical imprint on or use for the clip of a writing implement. Indeed, the Kehr reference is directed to a different purpose, that of a stationary and primarily ornamental display on a tie clip, and therefore, an inventor involved in the field of writing implements would have no reason to consider such a reference. *See, In Re Clay*, 23 USPQ 2d 1058, 1061 (Fed. Cir. 1992). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or

incentive to do so." *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992)(citations omitted). Here, there is suggestion or incentive to do so.

Applicant respectfully disagrees with Examiner on the rejection of claims 12, 13, 23 and 24 under §103 as unpatentable over Krause (1808045) in view of Kehr (2272674). Based on the above discussion, as well as that raised in conjunction with Krause, above, Applicant respectfully requests Examiner review these claims and recognize that the application is in condition for allowance.

### **Double Patenting Rejection:**

#### **Claims 1-24:**

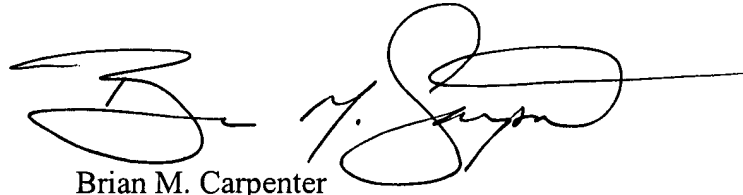
Applicant respectfully disagrees with the Examiner's conclusion of double patenting here, as there are distinct differences between the instant claims and those of Patent No. 6,685,374 B1. A patent may be granted on each of two applications if there is a patentable distinction between their respective claims. *In re Simmons*, 136 USPQ 450, 452 (C.C.P.A. 1963). Contrary to the Examiner's assertion, the elimination of the guide pin limitation renders the instant application a unique version, as a pin having any structure with the exception of a "tapered cylindrical element with a slit along its longitudinal axis" would be within the scope of the instant application. This is significantly broader than the claims of 6,685,374 B1, and therefore, a different and unique set of new claims. "The notion that a pending claim to a generic invention is necessarily patentably indistinct, in the sense of double patenting of the obviousness type, from a narrower patented claim encompassed by the pending generic claim was scotched by *In re Braat*, 937 F.2d 589 at 594, 19 USPQ2d 1289 at 1293 (Fed. Cir. 1991)." *Ex parte Michno*, 38 USPQ 2d 1211, 1212 (B.P.A.I. 1993); See, also, *In re Kaplan*, 789 F.2d 1574 at 1577, 229 USPQ 678 at 681 (Fed. Cir. 1986). Accordingly, the Applicant is entitled to a patent on the claims as presented in the instant application.

The Applicant disagrees with the Examiner, but has also amended this claim for further clarity as attached hereto. Applicant respectfully requests Examiner to review the claim amendments and recognize that the application is in condition for allowance.

## Conclusion

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and requests that such action be taken by the Examiner.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. M. Carpenter', with a long horizontal line extending to the right.

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